

**AMENDMENTS TO THE DRAWINGS:**

Applicant submits the attached new drawing sheet to add Fig. 1A. Fig. 1A shows features recited in claims 5-8 and 13-16.

Applicant submits the attached replacement drawing sheet to correct the typos in the blocks S13 and S18 in Fig. 3.

Attachment: One (1) new drawing sheet adding Fig. 1A and one (1) replacement drawing sheet amending Fig. 3.

### **REMARKS**

In the Office Action,<sup>1</sup> the Examiner:

- (a) objected to the drawings;
- (b) objected to the specification;
- (c) rejected claims 5-8 and 13-16 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement;
- (d) rejected claims 5-8 and 13-16 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; and
- (e) rejected claims 5-8 and 13-16 under 35 U.S.C. § 103(a) as being unpatentable over Oh et al. (U.S. Patent No. 7,251,480) ("Oh") in view of McConnell et al. (U.S. Patent Publication No. 2006/0030357) ("McConnell").

Applicant amends claims 5, 6, 13, and 14 to improve form and clarity. Upon entry of this Amendment, claims 5-8 and 13-16 remain pending. Applicant respectfully traverses the rejections and the objections for at least the following reasons.

#### **Objection to the drawings:**

The Examiner objected to the drawings. In particular, the Examiner stated that "the limitations claimed in claims 5-8 and 13-16 must be shown or the feature(s) canceled from the claims" (Office Action, p. 2). The Examiner further alleged that "fig. 3 does not show the invention claimed" (Office Action, p. 2).

Applicant traverses the objection. However, to expedite prosecution, Applicant has added a new figure, Fig. 1A, to show features recited in claims 5-8 and 13-16. No

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<sup>1</sup> The Office Action may contain statements characterizing the related art, case law, and claims. Regardless of whether any such statements are specifically identified herein, Applicant declines to automatically subscribe to any statements in the Office Action.

new matter has been introduced because support for Fig. 1A may be found in Applicant's specification at, e.g., paragraph [0012].

In addition, the Examiner objected to Fig. 3 "because fig. 3 misspells the word receive in box s13 and the word transcode in box s18" (Office Action, p. 2). In response, Applicant has amended Fig. 3 to correct these typos.

Therefore the objection is overcome and should be withdrawn.

**Objection to the specification:**

The Examiner objected to the specification. In particular, the Examiner alleged that "para. 1[4], lines 5-6 refer to the same data as a first data and second data. This is misleading since lines 1-4 describe this as the same data" (Office Action, p. 3).

Applicant traverses the objection. However, to expedite prosecution, Applicant has amended the specification to overcome the objection. Accordingly, the objection should be withdrawn.

In addition, the Examiner objected to the Abstract "because it does not accurately describe the claimed invention" (Office Action, p. 4). In response, Applicant has amended the Abstract to include features recited in independent claim 5.

**Rejection of Claims 5-8 and 13-16 under 35 U.S.C. § 112, first paragraph:**

The Examiner rejected claims 5-8 and 13-16 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement (Office Action, p. 5-7). In response, Applicant has amended claims 5, 6, 13, and 14 to overcome the rejection. Accordingly, the rejection should be withdrawn.

With respect to claims 7 and 15, the Examiner further alleged that there is no support for a second telephone terminal sending two different packets in two different encoding formats (Office Action, p. 6-7). Applicant traverses this rejection, and submits

that support for the claims may be found in Applicant's specification at, e.g., paragraph [0015].

**Rejection of Claims 5-8 and 13-16 under 35 U.S.C. § 112, second paragraph:**

The Examiner rejected claims 5-8 and 13-16 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (Office Action, p. 5-10). In response, Applicant has amended claims 5, 6, 13, and 14 to overcome the rejection. Accordingly, the rejection should be withdrawn.

With respect to claims 7 and 15, the Examiner further alleged that there is no support for a second telephone terminal sending two different packets in two different encoding formats (Office Action, p. 9-10). Applicant traverses this rejection, and submits that support for the claims may be found in Applicant's specification at, e.g., paragraph [0015].

**Rejection of Claims 5-8 and 13-16 under 35 U.S.C. § 103(a):**

Applicant respectfully traverses the rejection of claims 5-8 and 13-16 under 35 U.S.C. § 103(a), because no *prima facie* case of obviousness has been established for these claims.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007)*. "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." *M.P.E.P. § 2145*. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant

combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. *M.P.E.P. § 2143.01(III)*, *internal citation omitted*. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." *M.P.E.P. § 2141.02(I)*, *internal citations omitted* (emphasis in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966).... The factual inquiries ... [include determining the scope and content of the prior art and] ... [a]scertaining the differences between the claimed invention and the prior art." *M.P.E.P. § 2141(II)*. "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." *M.P.E.P. § 2141(III)*.

Here, a *prima facie* case of obviousness has not been established because the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

With respect to independent claim 5, claim 5 calls for a combination including, e.g., "an encoding format determining section which communicates with a first telephone terminal to determine an encoding format of audio data" (emphasis added). Oh does not teach or suggest at least this element of claim 5.

The Examiner alleged that "Oh discloses ... an encoding format determining section which communicates with a first telephone terminal to determine an encoding format of audio data" (Office Action, p. 11). However, this is not correct.

Oh discloses a method that "includes receiving the voice mail message in a first format being sent from the first terminal through a wireless network to a voice mail server, and making a determination of whether the second terminal is a mobile station" (col. 2, lines 34-37, emphasis added). According to Oh, "[i]f the determination is that the second terminal is not a mobile station, then the voice mail message is transcoded into a second format before sending the voice mail message to the voice mail server. If the determination is that the second terminal is a mobile station, then the voice mail message is sent to the voice mail server in the first format" (col. 2, lines 38-43, emphasis added). However, neither the portion of Oh cited by the Examiner nor any other portion of Oh teaches or suggests "an encoding format determining section which communicates with a first telephone terminal to determine an encoding format of audio data," as recited in claim 5 (emphasis added).

McConnell fails to cure the deficiencies of Oh. The Examiner alleged that "McConnell does disclose a packet converting section" (Office Action, p. 11). However, whether this allegation is correct or not, neither Oh, nor McConnell, nor any combination thereof, teaches or suggests "an encoding format determining section which communicates with a first telephone terminal to determine an encoding format of audio data," as recited in claim 5 (emphasis added).

In view of the shortcomings of the prior art and the errors in analysis of the prior art set forth in the Office Action, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the

claimed invention and the prior art. Moreover, there is no motivation for one of ordinary skill in the art to modify the references to achieve the claimed combinations. Thus, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art. Accordingly, no *prima facie* case of obviousness has been established. The 35 U.S.C. § 103(a) rejection of independent claim 5 and, hence, dependent claims 6-8 is therefore improper and should be withdrawn.

Independent claim 13, although different in scope from claim 1, recites elements similar to claim 5 and is thus allowable for at least the reasons discussed above with respect to claim 5. Therefore, the 35 U.S.C. § 103(a) rejection of independent claim 13 and, hence, dependent claims 14-16 is also improper and should be withdrawn.

**Conclusion:**

In view of the foregoing, Applicant requests reconsideration of the application and withdrawal of the rejection. Pending claims 5-8 and 13-16 are in condition for allowance. Accordingly, Applicant requests a favorable action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: August 5, 2010

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Attachment: One (1) new drawing sheet adding Fig. 1A and one (1) replacement drawing sheet amending Fig. 3.